

REMARKS

Claims 7-29 are pending in this application. In the outstanding Official Action, the Examiner has required restriction of claims 7-29 to a single invention under 35 U.S.C. §§121 and 372. Claims 7-29 were subjected to a restriction requirement as follows:

- Group I - Claims 7-17 and 26-27 in part, and 28-29, are drawn to a JEV cDNA and a vector including JEV cDNA;
- Group II - Claims 26-27 in part, are drawn to elements from the cDNA of JEV;
- Group III- Claims 18-21, are drawn to an infectious JEV RNA transcript and a cell transfected with JEV RNA transcript;
- Group IV- Claims 22-23, are drawn to a synthetic JEV;
- Group V- Claims 24-25, are drawn to a method for the expression of heterologous genes.

If Group I is elected, the Examiner has further required the election of one sequence from the following sequences:

SEQ ID NO: 43;

SEQ ID NO: 44;

SEQ ID NO: 45;

SEQ ID NO: 46;

SEQ ID NO: 47;

SEQ ID NO: 48.

RESPONSE

Applicants hereby provisionally elect claims 7-17 and 26-27 in part, and 28-29 of Group I, and SEQ ID NO: 45 with traverse. Applicants reserve the right to file a divisional application directed to the non-elected subject matter. Applicants respectfully traverse the Examiner's restriction requirement for the following reasons.

Applicants respectfully traverse this restriction/election requirement because the previously amended claim set share a **special technical feature** under PCT Rule 13.2, and thus, all of the presently pending claims possess unity of invention. Accordingly, restriction is improper.

PCT Rule 13.2 states the following, in relevant part:

“[T]he requirement of unity of invention referred to in Rule 13.1 shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression ‘special technical features’ shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.”

In the present application, the special technical feature that is shared between Groups I-V is a full-length infectious and genetically stable cDNA clone of Japanese encephalitis virus which was first invented by the present inventors. Although there were many efforts to produce a functional cDNA clone capable of producing an infectious RNA transcript of JEV and an intact synthetic JEV therefrom, there has been no successful result before the present invention. Such a special technical feature of the present invention is novel and contributes

to the prior arts as a whole, and links groups I to V. Thus, the restriction requirement should be reconsidered.

In view of the foregoing, Applicants respectfully submit that the claims of Groups II-V possess "unity of invention" because they share a special technical feature as required by PCT Rule 13.2. Thus, restriction of the claims of Groups I-V is improper. Accordingly, the Examiner is respectfully requested to reconsider and withdraw the restriction requirement of the claims of Groups I-V.

Applicants further submit that the claims of all of Groups I-V should be examined together because, in addition to being improper on the basis of unity of invention, the restriction requirement is further traversed because it omits "an appropriate explanation" as to the existence of a "serious burden" if a restriction were not required between the claims. See MPEP § 803. A complete and thorough search for the inventions set forth in the Official Action would be coextensive. Thus, it would not be a **serious** burden upon the Examiner to examine all of the claims in this application.

Furthermore, applicants have paid a filing fee for an examination of all the claims in this application. If the Examiner refuses to examine the claims paid for when filing this application and persists in requiring applicants to file divisional applications for each of the groups of claims, the Examiner would essentially be forcing applicants to pay duplicative fees for the non-elected or withdrawn claims, inasmuch as the original filing fees for the claims (which would be later prosecuted in divisional applications) are not refundable.

CONCLUSION

Having made the required election, examination on the merits is earnestly solicited. Should the Examiner deem that any further action by Applicants' undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicants petition for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

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